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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,626	09/20/2000	Dieter Bauerfeind	10677/31	5098

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NEW YORK, NY 10004

EXAMINER
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BECKER, SHAWN M

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/646,626

Applicant(s)

BAUERFEIND, DIETER

Examiner

Shawn M. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This action is in response to communication filed 5/29/03.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,877,957 to Bennett (hereinafter Bennett).

3. Referring to claims 10, 20, and 21, Bennett teaches a programmable controller (col. 3, line 33) comprising a processing unit/means (Fig. 2, CPU 26), a display screen/means including a menu-assisted user interface (Fig. 19 and col. 15, lines 18-22), an operator unit including a button, the button capable of being switched to an active mode using a programmable function (see col. 15, line 65 - col. 16, line 34 which describes activating one of the keypad buttons to be a trigger event for switching the mode of a device after selecting the "Training" button) at least one signal input (i.e. trigger event; col. 2, line 39), at least one signal output (broadcast control signal; see col. 3, lines 47-57) and a housing unit in which the processing unit, the display screen, the operator unit, the at least one signal input, and at least one signal output are disposed. See col. 15, lines 18-65 and Fig. 19.

Bennett discloses a switching function of the controller programmable in a programmed sequence according to predetermined functions using the menu-assisted user interface, and

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wherein an operation of the button is capable of affecting a switching sequence of the switching function when the button is in the active mode. See col. 15, line 65 - col. 16, line 34, which describes how selection of the keypad button that is the trigger event switches at least one of the devices in the house.

Referring to claim 11, an operation of the button of Bennett can simulate the at least one signal input when the button is in the active mode. See col. 8, lines 7-10. Also, see col. 15, line 65 - col. 16, line 34, which describe using a button on the programmable controller as the trigger event to turn on a lamp instead of the turning on of a different lamp as in Fig. 10, for example.

Referring to claims 12-13, the [programmed sequence of the] switching function of Bennett is interrupted when the button (trigger event) is operated in the active mode. See col. 2, lines 26-47.

Referring to claim 14, the operation of the button of Bennett is performable at any point of the programmable switching function. See col. 16, lines 36-43, which shows a menu option for allowing the switch to occur at all times.

Referring to claim 15-16, Bennett shows a second button capable of affecting the switching function and capable of being switched to an active mode. See the plurality of button on the keypad in Fig. 19 and col. 15, line 65 - col. 16, line 34.

Referring to claim 17, the display screen of Bennett is capable of displaying an instruction to operate the active button. See Fig. 19, and example instructions at col. 16, lines 25-30.

Referring to claim 19, the switching function of Bennett is arranged to switch between input voltages applied to the signal input and the signal output. For example, see col. 5, lines 10-

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34 and 49-62, which describe an input trigger event, which may be a device turning on (requiring voltage), that causes a device (i.e. lamp) to turn on (output voltage).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett and U.S. Patent No. 5,997,167 to Crater et al. (hereinafter Crater).

The display screen of Bennett is capable of displaying an instruction to operate the active button. See Fig. 19, and example instructions at col. 16, lines 25-30. Bennett also shows a speaker in Fig. 19, but does not explicitly state that the instruction to operate the active button is accompanied by an acoustic signal. However, Crater discloses a programmable controller with diagnostic and simulation facilities that plays an audible alarm (acoustic signal) along with directions on the display. See col. 6, lines 39-44. It would have been obvious to one of ordinary skill in the art to use the speaker of Bennett to play an acoustic signal that accompanies the display of an instruction to operate the active button in order to capture the operator's attention as supported in Crater.

***Response to Arguments***

6. Applicant's arguments, see pages 3-6, filed 5/29/03, with respect to the rejection of claims 10-18 under 35 U.S.C. § 112 have been fully considered and are persuasive. The rejection of claims 10-18 under 35 U.S.C. § 112 has been withdrawn.

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7. Applicant's arguments with respect to claims 10-21 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

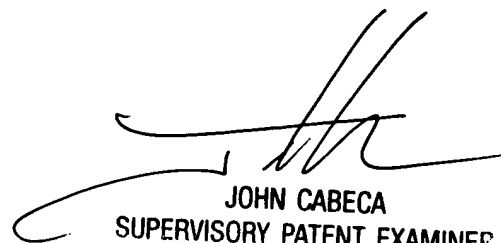
8. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach programmable controllers with interfaces for controlling switching functions and running diagnostics.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is 703-305-7756. The examiner can normally be reached on M-Th 8:00 - 5:30 and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on 703-305-3116. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

smb  
August 7, 2003

  
JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100